

**REMARKS**

Claims 27-46 have been examined and have been rejected under 35 U.S.C. § 103(a).

**I. Preliminary Matters**

Regarding the September 22, 2000 Information Disclosure Statement, the Examiner maintains that document DE 296 19 764 has not been considered as to its merits because document DE 296 19 764 allegedly does not comply with 37 C.F.R. § 1.98(a)(i) or (a)(ii). However, as set forth in the January 8, 2003 Amendment, when filing the Information Disclosure Statement, Applicant submitted a copy of a **European Search Report** (in English) which disclosed each document cited in the Information Disclosure Statement.

In accordance with MPEP § 609, a translation of a non-English language reference is not required when an IDS is submitted with a concise explanation of the relevance of a cited document submitted for each patent, publication, or other information listed in an IDS that is not in the English language (See MPEP 609, and 37 C.F.R. § 1.98(a)(3)). When a document is cited in a foreign patent office action or **search report**, the statement of relevance may be a translation of the portion of the foreign office action indicating the relevance found for the documents. However, in the current case, the search report is already in the English language. Therefore, Applicant submits that the submission of the foreign office action fully satisfies the requirements under MPEP § 609.

Accordingly, the cited reference should be considered by the Examiner. Applicant provides a duplicate Form-1449, listing the references, for the Examiner's initials. Also, in order to expedite prosecution, Applicant is submitting herewith a partial translation of DE 296 19 764.

Since such submission is not required under MPEP § 609, due to Applicant's previous submission of the European Search Report, Applicant submits that the Information Disclosure Statement filed on September 22, 2000 is in full compliance with MPEP § 609.

The Examiner has objected to the specification because it does not recite the claim limitation of a "simple audio player". However, as acknowledged by the Examiner, the specification recites an "unsophisticated audio player". Since the term "simple" is synonymous with the term "unsophisticated," Applicant has amended the specification to acknowledge that both terms can be used interchangeably, as requested by the Examiner.

Applicant submits that such amendment complies with MPEP § 608.01(o), which states that, "[w]hile an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims." Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the objection.

**II. Rejections under 35 U.S.C. § 103(a) over U.S. Patent No. 5,896,358 to Endoh et al. ("Endoh") in view of U.S. Patent No. 5,809,201 to Nagasawa ("Nagasawa").**

The Examiner has rejected claims 27-46 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Endoh in view of Nagasawa.

As an initial matter, the Examiner maintains that any claim references to both "video" and "audio" zones have been removed from the claims by amendment (pg. 3 of Office Action).

However, the term “audio zone” was never removed from claims 27, 37, 40, 41 and 44 by amendment. Further, the term “video” zone was never recited in claims 27-44, which were originally submitted in the March 20, 2003 Preliminary Amendment. Accordingly, Applicant submits that such terms were not “removed” by amendment.

**A. Claim 27**

Applicant submits that claim 27 is patentable over the cited references. For example, claim 27 recites an audio zone that includes substantive data, first control data and second control data for reproducing the substantive data. The audio zone further includes an audio title set and an audio manager for managing the audio title set. The audio title set includes the substantive data and the first control data. Further, the second control data is recorded at a head of the audio zone.

The Examiner maintains that Endoh and Nagasawa disclose the above features. In particular, regarding Endoh, the Examiner maintains that the first code information discloses the claimed first control data, and the second code information discloses claimed second control data. As taught in col. 3, lines 9-16 of Endoh, the first code information is for determining a “surround mode,” while the second code information is for determining a “special use” mode. The audio coding information for the surround mode and the special use mode is written in the bit stream information BSI (col. 29, lines 27-35). The BSI is contained in the frame header 424 along with the synchronizing information header SI (Fig. 54; col. 29, lines 19-22). Based on such disclosure, Applicant submits that both the first code information (i.e. alleged first control

data) and the second code information (i.e. alleged second control data) are recorded in the same area (i.e. BSI).

On the contrary, as set forth above, claim 27 recites that the first control data is included with the audio title set, while the second control data is recorded at a head of the audio zone (i.e. different areas). Since Endoh discloses that both of the alleged control data are recorded in the same area (i.e. the BSI in frame header 424), Applicant submits that Endoh fails to teach or suggest the positioning of the claimed first and second control data.

Further, Applicant submits that Nagasawa fails to cure the deficient teachings set forth above.

Accordingly, Applicant submits that claim 27 is patentable over the cited references and respectfully requests the Examiner to reconsider and withdraw the rejection.

**B. Claims 37, 40, 41 and 44**

Since claims 37, 40, 41 and 44 contain features that are analogous to the features recited in claim 27, Applicant submits that such claims are patentable for at least analogous reasons as presented above.

**C. Claim 28**

Applicant submits that claim 28 is patentable over the cited references. For example, claim 28 recites that the first control data is dispersed on the basis of the titles to be recorded on a recording medium.

In the rejection of claim 27, the Examiner maintains that the first code information of Endoh discloses the claimed first control data (col. 3, line 12). However, the first code information is for determining a “surround mode.” The reference fails to teach or suggest that information for determining a surround mode is dispersed on the basis of titles to be recorded on a recording medium. Therefore, Endoh fails to teach or suggest the features of claim 28.

Since Nagasawa fails to cure the deficient teachings of Endoh, as set forth above, Applicant submits that claim 28 is patentable over the cited references.

In addition, since claim 28 is dependent upon claim 27, Applicant submits that such claim is patentable at least by virtue of its dependency.

**D. Claim 29**

Applicant submits that claim 29 is patentable over the cited references. For example, claim 29 recites a first track being reproduced by using both of the first control data and the second control data, and a second track being reproduced by using the first control data.

As acknowledged by the Examiner, the Endoh reference recites that first and second-type accompanying sounds can be selected by a user (col. 5, lines 43-45). However, the fact that sounds can be selected by a user fails to teach or suggest the claimed features. For example, the first and second-type accompanying sounds are disclosed for use in the “special use” mode (col. 5, line 33-39). As discussed above, the “special use” mode is determined by the second code information. Therefore, even if Applicant assumes *arguendo* that the accompanying sounds

discloses a first and second track, the reference fails to suggest that either of the alleged tracks are reproduced using the first code information (i.e. the alleged first control data).

Since Nagasawa fails to cure the deficient teachings of Endoh, as set forth above, Applicant submits that claim 29 is patentable over the cited reference.

In addition, since claim 29 is dependent upon claim 27, Applicant submits that such claim is patentable at least by virtue of its dependency.

**E. Claims 30, 31, 32, 33 and 34**

Since claims 30, 31, 32, 33 and 34 are dependent, either directly or indirectly, upon claim 27, Applicant submits that such claims are patentable at least by virtue of their dependency.

**F. Claim 35**

Applicant submits that claim 35 is patentable over the cited references. For example, claim 35 recites that the second control data is required when reproducing the substantive data in Linear Pulse Code Modulation.

The Examiner refers to col. 22 of Endoh as disclosing the above feature. The cited portions disclose that, “[w]hen ‘100’ is written for the audio coding mode, this means that the audio data is coded by linear PCM” (col. 22, lines 10-11). Although the cited portion discloses that audio data can be coded by linear PCM, the portion fails to disclose that the second code information (i.e. alleged second control data) is required when coding the data by linear PCM.

In particular, the cited portion fails to disclose that the second code information is even used, let alone required, during coding by linear PCM.

Further, Applicant submits that Nagasawa fails to cure the deficient teachings of Endoh.

Accordingly, Applicant submits that claim 35 is patentable over the cited references, and respectfully requests the Examiner to reconsider and withdraw the rejection.

In addition, since claim 35 is dependent upon claim 27, Applicant submits that such claim is patentable at least by virtue of its dependency.

**G. Claim 36**

Applicant submits that claim 36 is patentable over the cited references. For example, claim 36 recites that the second control data at least includes address information, attribute information, and reproduce time, each relating to one or a plurality of tracks.

The Examiner maintains that Endoh discloses the above features. In particular, the Examiner refers to col. 15, lines 48-53 of Endoh. However, such portion merely discloses that attribute information is stored in a volume manager information management table 278. There is no disclosure that the information is included in the second code information (i.e. alleged second control data), as recited in claim 36.

Accordingly, since Nagasawa fails to cure the deficient teachings of Endoh set forth above, Applicant submits that claim 36 is patentable over the cited references.

In addition, since claim 36 is dependent upon claim 27, Applicant submits that such claim is patentable at least by virtue of its dependency.

Amendment under 37 C.F.R. § 1.116  
U.S. Application No. 09/285,772

**H. Claims 38, 39, 42, 43, 45 and 46**

Since claims 38, 39, 42, 43, 45 and 46 are dependent upon one of claims 37, 40, 41 and 44, Applicant submits that such claims are patentable at least by virtue of their dependency.

**III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Allison M. Tulino  
Registration No. 48,294

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 1, 2004





File reference: 296 19 764.5

Date of application: 11.13.96

Date of registration: 1.16.97

Publication in

patent bulletin: 2.27.97

**RECEIVED**

APR 05 2004

Technology Center 2600

Proprietor:

Reger, Gerd, 80803 München, DE; Rehm, Walter,  
80337 München, DE; Schiller, Bernd, 81539 München,  
DE

Digital video disc (DVD) for audio CD players

Application for registration of a utility model:

Digital Video Disc (DVD) for Audio CD players

ANNEX 1

Description

The invention comes from the field of digital storage media.

Picture/sound information which, according to the DVD standard, is stored in digital form, having been compressed and encoded, on a DVD can to date be played back only on DVD players.

The invention specified in patent claim 1 is based on the problem of playing back this information or some of the information on conventional playback units (e.g. CD players) as well.

The means used to this end are intended to be the additional storage of the information or of some of the

information in the form which can be read by conventional playback units (e.g. CD players).

Exemplary embodiment: The desired picture/sound information is stored on a DVD using ordinary methods. In addition, the sound information is stored a second time in the form which is usual for sound recording media (audio CDs). This can be done on the same side or on the reverse side of the DVD.

The advantage of the digital video disc (DVD) for audio CD players is that it can be played back on conventional CD players like an audio CD, and at the same time is already suitable for new DVD players. It is thus a piece of software which is upwardly and downwardly compatible.

This is of great interest particularly in the field of music.

The more widespread the playback units using the new DVD technology become, the greater the extent to which CDs (music for listening) become superseded by DVDs (music for listening and viewing). This can already be seen today from the attractiveness of pure music television programs in the field of pop music, but it is also becoming

relevant in the classical field (e.g. live concert recordings).

The DVD for audio CD players can be marketed like an audio CD today and is at the same time already suitable for the future market. It is thus not only the ideal transitional medium but at the same time serves to open up the new market more quickly.

Application for registration of a utility model:

Digital Video Disc (DVD) for audio CD players

ANNEX 2

Patent Claims

1. A digital video disc (DVD),

wherein

the disc can be played back not only on DVD players but also on conventional playback units (e.g. audio CD players).

2. The digital video disc (DVD) as claimed in patent claim 1,

wherein

the data, or some of the data, stored on the disc in the form which can be read by DVD players are additionally stored (e.g. on the reverse) in the form which can be read